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PTO/SB/64 (09-06)

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

06037

First named inventor: Tierney

Application No.: 10/068,196

Art Unit: 3618

Filed: 02-04-2002

Examiner: Swenson

Title: Steerable In-Line Street Ski

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (571) 273-8300

10/23/2006 HDEMESS1 00000028 10068196

01 FC:2453

750.00 OP

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☒ Small entity-fee \$ 750.00 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee \$ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of Amendment A (identify type of reply):

☐ has been filed previously on _____.
☒ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ _____.

☐ has been paid previously on _____.
☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

3. Terminal disclaimer with disclaimer fee

☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Charles F. Meroni, Jr.
Signature

10/18/2006
Date

Charles F. Meroni, Jr.
Typed or printed name

20,109
Registration Number, if applicable

P.O. Box 309
Address

847-304-1500
Telephone Number

Barrington, IL 60011
Address

Enclosures: ☒ Fee Payment

☒ Reply

☐ Terminal Disclaimer Form

☒ Additional sheets containing statements establishing unintentional delay

☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

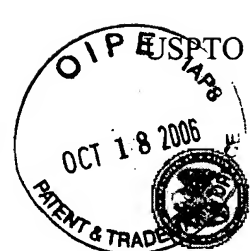
I hereby certify that this correspondence is being: EXPRESS

☒ Deposited with the United States Postal Service on the date shown below with sufficient postage as ~~first class~~ mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

10/18/06
Date

Christopher J. Scott
Signature
Christopher J. Scott
Typed or printed name of person signing certificate



United States Patent and Trademark Office

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Assignments on the Web > Patent Query

Patent Assignment Details

NOTE: Results display only for issued patents and published applications. Pending or abandoned applications please consult USPTO staff.

Reel/Frame: 013565/0193

Pages:

Recorded: 09/10/2002

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Total properties: 2

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------|
| <p>1 Patent #: NONE Issue Dt:</p> <p>Publication #: <u>US20020067015</u> Pub Dt: 06/06/2002</p> <p>Title: Steerable in-line skateboard</p> | <p>Application #: 10039570 Filing Dt: 10/26/2</p> |
| <p>2 Patent #: NONE Issue Dt:</p> <p>Publication #: <u>US20020195788</u> Pub Dt: 12/26/2002</p> <p>Title: Steerable in-line street ski</p> | <p>Application #: 10068196 Filing Dt: 02/04/2</p> |

Assignors

- | | |
|------------------------------------|----------------------------|
| 1 <u>TIERNEY, KURT</u> | Exec Dt: 07/28/2002 |
| 2 <u>TIERNEY, TYLER</u> | Exec Dt: 07/28/2002 |
| 3 <u>WOZNY, THOMAS A.</u> | Exec Dt: 07/31/2002 |
| 4 <u>NANOS, NICHOLAS</u> | Exec Dt: 08/08/2002 |
| 5 <u>HEILIGENSTEIN, LUC</u> | Exec Dt: 07/26/2002 |

Assignee

- 1** TIERNEY RIDES LLC
 2155 STONINGTON AVENUE, SUITE 208
 HOFFMAN ESTATES, ILLINOIS 60195

Correspondence name and address

BARNES & THORNBURG
 RICHARD B. LAZARUS
 750 17TH STREET, N.W., SUITE 900
 WASHINGTON, D.C. 20006

Search Results as of: 10/18/2006 11

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350.
 Web interface last modified: July 26, 2006 v.1.10

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CERTIFICATE OF EXPRESS MAILING

Hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Express Mail No. EV 819 358 879 US in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on

Date: 10/18/06 Signed: Christopher J. Scott By: Christopher J. Scott

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
OFFICE OF THE COMMISSIONER FOR PATENTS**

Applicant(s) Tierney et al.)
)
Petitioner: TIERNEY RIDES, LLC)
)
Serial No.: 10/068,196)
)
Filing Date: February 4, 2002)
)

**Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. 1.137(b)**

Dear Honorable Commissioner:

Petitioner, TIERNEY RIDES, LLC, the current owner of record of U.S. Patent Application No. 10/039,570, by and through its recently retained legal representative, MERONI & MERONI, P.C., hereby petitions the Honorable Commissioner for Patents to revive the subject application for patent abandoned "unintentionally" as that term has been construed under the provisions of 37 C.F.R. 1.137(b). It is Petitioner's contention that revival of the subject application for patent is warranted and justified under the provisions embodied in 37 C.F.R. 1.137(b) as the failure to respond to the Office Action dated February 26, 2004 (OFFICE ACTION) was unintentional for the reasons stated hereinafter. Petitioner submits that the present Petition is a timely Petition in light of the unintentional nature of Petitioner's past failure to timely respond to the OFFICE ACTION.

ISSUE PRESENTED FOR REVIEW:

Whether Applicants'/Petitioner's abandonment of U.S. Patent Application No. 10/068,196 was unintentional within the meaning of 37 C.F.R. § 1.137(b), thereby justifying the revival of the subject application for continued prosecution on its merits.

RELIEF REQUESTED:

Patent Application Revival under 37 C.F.R. 1.137(b).

Petitioner respectfully petitions the Honorable Commissioner to revive U.S. Patent Application No. 10/068,196 and consider Petitioner's response to the Office Action dated February 26, 2004.

STATEMENT OF FACTS

Applicant(s) Tyler Tierney, Kurt Tierney, Thomas A. Wozny, Nicolas Nanos, and Luc Heiligenstein assigned their respective rights to the subject application without dating any of the assignment paperwork, but which assignment paperwork was received in the Office of Initial Patent Examination (OIPE) (notably not the Assignment Division) of the United States Patent and Trademark Office on September 10, 2002 along with Assignment Recordation Fee(s) of \$160.00 (assignments of U.S. Patent Application No. 10/039,570; and International Patent Application Nos. PCT/US01/46049 and PCT/US0214678 were also to be recorded at that time). A copy of the Assignment paperwork is enclosed and marked as Exhibit A (11p) for the Commissioner's quick

inspection. A copy of an OIPE date stamped postcard evidencing receipt of certain assignment recordation fee(s) is enclosed and marked as Exhibit B (1p). Further, Petitioner submits herewith a Statement under 37 C.F.R. 3.73(b) along with a copy of a USPTO web-site printout of the Reel/Frame number evidencing Petitioner's ownership of the subject application. Petitioner thus contends that it has proper standing to petition the Commissioner for Patents for revival of the subject application based on these preliminary statements of fact as supported by the noted documentary evidence as lodged in the United States Patent and Trademark Office, despite certain previous attorneys' mishandling of the matter(s).

Ms. Sandy Hogan was hired by Petitioner as Chief Operations Officer (COO) in December of 2000. Ms. Hogan was terminated from employment in October 2001, less than one year later. During this time, Petitioner was developing a new product line, namely, a steerable, in-line street ski. Barnes & Thornburg, the previous attorneys of record, were referred to Petitioner via a friend (unknown) of Ms. Hogan as a reputable law firm capable of providing Petitioner with certain legal services to properly protect certain utilitarian intellectual property inherent in its newly developing product as well as certain source-identifying intellectual property also associated with the newly developing product.

Indeed, Barnes & Thornburg is a large, multi-state firm. The firm maintains a web-site at: www.btlaw.com. A copy of a firm's history page is enclosed and marked as Exhibit C (1p). Notably, as is well known in the industry and as is confirmed by a further inspection of the web-site, it is clear that the firm has an extensive intellectual property

practice. A copy of the firm's intellectual property page is further enclosed and marked as Exhibit D (3p).

As Petitioner's COO, Ms. Hogan assumed power to handle Petitioner's intellectual property matters as Messrs. Tierney and Tierney (owners of Petitioner) were busy traveling, promoting the product lines then offered by Petitioner. Ms. Hogan, with reigns in hand, embarked in search of an intellectual property bonanza during this time. Notably, the undersigned has been in practice for over 40 years in the field and has had considerable experience working with large intellectual property firms. Never has this writer ever witnessed so much expenditure for such a small outfit in so little time. As earlier noted, Ms Hogan was terminated less than one year after being hired by Petitioner and during the course of her tenure obliged Petitioner in excess of \$500,000, roughly half of which was spent on various intellectual property projects, most of which were not authorized and most of which were frivolous (as admitted by Mr. Thomas J. Donovan, partner with Barnes & Thornburg, and discussed in more detail hereinafter).

The grounds for Ms. Hogan's termination are easily understood when one considers the following examples of her unlawful behavior to which Petitioner fell victim: (1) signing checks without authorization; (2) reimbursing herself out of Petitioner's accounts for personal items (such as sink hardware and bathroom accessories); (3) no accounting for outstanding Purchase Orders; (4) hiding Purchase Orders; (5) authorizing Purchase Orders without obtaining proper approval; (6) hiding spent money by spending more money (i.e. seeking venture capital to cover lost money); and (7) entering into long-term (and costly) contracts without authorization.

More readily understood everyday terms descriptive of the foregoing types of

behavior are embezzlement, fraud, and theft. Petitioner thus fell victim to Ms. Hogan's unlawful behavior, which behavior left Petitioner with unknown debts to unknown creditors and thus, Petitioner had no way of knowing the degree to which its budget for the patent application in question had been undermined by Ms. Hogan and abetted by Barnes & Thornburg.

To be sure, Barnes & Thornburg is not without guilt. By Barnes & Thornburg's own admission (as orally stated by Mr. Thomas J. Donovan, a partner at Barnes & Thornburg (See Exhibit E (1p)) to Mr. Kurt Tierney) roughly 70% - 80% of the intellectual property projects authorized by Ms. Hogan were not necessary to properly protect the intellectual property assets owned by Petitioner. In this regard, Mr. Donovan stated to Mr. K. Tierney of Petitioner, that roughly 20% - 30% of the projects were legally necessary or required and roughly 70% – 80% of the projects were frivolous. Simple math would thus seem to indicate that roughly \$200,000 was spent on unnecessary projects, which unnecessary projects were never authorized by Petitioner. Having no notice from Barnes & Thornburg (i.e a reputable intellectual property law firm) that any many of the filings were excessive, Petitioner's coffers continued to be depleted.

Enclosed herewith and marked as Exhibit F (4p) is a listing of all the patent applications and trademark applications on file with the United States Patent and Trademark Office and elsewhere as authorized by Ms. Hogan and filed by Barnes & Thornburg. Petitioner further notes that a great deal of the work product as provided Petitioner is rather shoddy. Case in point: the subject application. It will be noted from an inspection of the File Wrapper that, most notably, the patent application itself is

replete with informal errors and such. Errors of this type no doubt needlessly cost Petitioner additional out-of-pocket expense. Petitioner thus further questions whether its then attorneys of record ought to also be held liable for needlessly incurring added expense with regard to the various projects.

Nevertheless, Petitioner takes note that a delay resulting from a deliberately chosen course of action on the part of an applicant does not become an “unintentional” delay within the meaning of 37 C.F.R. 1.137(b) because the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses. Petitioner takes further note that the unavoidable delay standard is the “epitome” of “unintentional” delay. Notably, in this case, it ever was and continues to be Petitioner’s intention to obtain a patent. Petitioner did NOT simply seek to defer patent fees and patent prosecution expenses by deferring patent prosecution fees. Indeed, Petitioner has been forced to incur more than its rightful share of patent prosecution fees, and will continue to do so until it has recouped all that which was lost (and is to be regained). Petitioner fell victim to certain unlawful behavior and thereby having been robbed of its investment to fund the patent and trademark projects (as listed in Exhibit F), its failure to respond to the Office Action in the subject application was more a result of the noted unlawful behavior of an outside party and less a result of any sort of intentional delay question.

Petitioner notes that decisions on reviving abandoned applications on the basis of unintentional delay have adopted the reasonably prudent person standard in determining if the delay was unintentional. Given that even docketing errors have been held to provide grounds for upholding a finding of even unavoidable delay, surely being the

recipient of mischievous, fraudulent bank account depletion may be reasonably held to fall within the unintentional category. Indeed, as U.S. Petitions Attorney Edward J. Tannouse implicitly notes in the Decision on Petition dated February 3, 2006 issued with respect to the revival of U.S. Patent Application No. 10/039,570 (parent application to the subject application) (a copy of which is attached hereto and marked as Exhibit G), that the grounds set forth in the forgoing statement of facts tend to support revival of an otherwise abandoned application provided Petitioner, in good faith and under a duty of candor, explicitly states for the record that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

Petitioner originally consulted outside counsel (Meroni & Meroni, P.C.) in September 2005 at which time Petitioner had satisfied many of its outstanding debts and was in a position to further its intellectual property projects, if possible. After having divulged the foregoing series of events to the undersigned, counsel for Petitioner recommended that all intellectual property files be transferred to Meroni & Meroni, P.C. from Barnes & Thornburg. Having received the files and reviewed the various matters that then were dormant or abandoned, counsel advised Petitioner as to its remedies, if any.

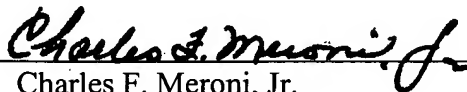
It will be reiterated that the parent application to this application, namely, U.S. Patent Application No. 10/039,570 was made the subject of a similar petition for revival in November of 2005. Although revived, said parent application has received no further action as of this writing. Nevertheless, in the months that followed the earlier Decision on Petition issued with respect to the parent of this application, Petitioner prepared for filing this petition as it returned to solvency.

It ever was and continues to be Petitioner's intent to prosecute U.S. Patent Application No. 10/069,196. Petitioner hereby acknowledges its duty of candor, and in good faith states for the record that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. Petitioner submits that the delayed response to the Office Action was the result of being faced with bankruptcy or continued patent prosecution, which bankruptcy was unlawfully forced upon Petitioner. In an effort to remain credible in the financial community, Petitioner was essentially forced to discontinue prosecution of the subject patent application (and indeed all other applications then pending with the United States Patent and Trademark Office, and indeed its business in general). In this last regard, the Honorable Commissioner is invited to inspect the United States Patent and Trademark Office records as a way to confirm that all the applications on file with the United States Patent and Trademark Office, not then finalized, were unintentionally abandoned for the same or similar reasons.

Petitioner hereby prays for relief from the Honorable Commissioner for Patents. In accordance with the several provisions of 37 C.F.R. 1.137(a), Petitioner hereby submits a response to the Office Action and a fee for this Petition. Further, if issues remain which may be resolved by a telephone interview, the Commissioner is cordially invited to call Petitioner's undersigned attorney.

Respectfully submitted,
Attorney for Applicant

DATED: 10/18/06
MERONI & MERONI, P.C.
P.O. Box 309
Barrington, IL 60011
847.304.1500 telephone



Charles F. Meroni, Jr.
Registration 20,109

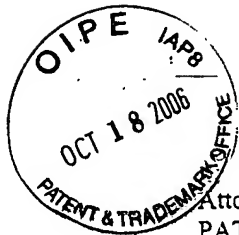


EXHIBIT A

Attorney Docket No. 27734-92540; 27734-93149; 27734-93534; 27734-92923
PATENT

RECORDATION OF ASSIGNMENT OF PATENTS

Box Assignments
Assistant Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Attn: Assignment Branch - Patents

Sir:

It is requested that the Assignment Branch record the properties listed below.

1. CONVEYING PARTIES: Kurt Tiernev; Tyler Tiernev; Thomas A. Wozny; Nicholas Nanos; and
Luc Heiligenstein
2. RECEIVING PARTY: Tiernev Rides LLC
2155 Stonington Avenue, Suite 208. Hoffman estates, Illinois 60195
3. INTEREST CONVEYED: Assignment
- EXECUTION DATES: Undated; Undated; July 31, 2002; August 8, 2002; and July 26, 2002
4. PROPERTIES: U.S. Application Serial No. 10/039,570; PCT International Application No.
PCT/US01/46049; U.S. Application Serial No. 10/068,196; and PCT
International Application No. PCT/US02/14678
5. CORRESPONDENCE ADDRESS: Barnes & Thornburg
750 17th Street, N.W., Suite 900
Washington, D.C. 20006
(202) 289-1313
6. FEE CALCULATION: 4 x \$40 = \$160.00

7. A check in the amount of \$160.00 made payable to the Director of Patents and Trademarks is attached hereto.
8. Should there be any over- or under-payment, authorization to apply or charge the Deposit Account of Barnes & Thornburg, No. 02-1010 (27734-92540; 27734-93149; 27734-93534; 27734-92923) therefore is hereby granted.
9. The undersigned states that to the best of my knowledge and belief, the information contained on this cover sheet is true and correct and any copy submitted herewith is a true copy of the original document.

Total number of pages including cover sheet, attachments and documents: 11

Respectfully submitted,

BARNES & THORNBURG

Richard B. Lazarus
Reg. No. 48,215
(202) 289-1313

ASSIGNMENT

WHEREAS the undersigned, THOMAS A. WOZNY, Roselle, IL, is the maker of an invention that is the subject of a utility patent application filed with the United States Patent and Trademark Office entitled STEERABLE IN-LINE SKATEBOARD, U.S. Application Serial No. 10/039,570, filed October 26, 2001, and PCT Int'l Application No. PCT/US01/46049, filed October 31, 2001; and a utility application entitled STEERABLE IN-LINE STREET SKI, U.S. Application Serial No. 10/068,196, filed February 4, 2002 and PCT Int'l Application No. PCT/US02/14678, filed May 8, 2002 ("the Applications"); and

WHEREAS, TIERNEY RIDES LLC, is a Delaware corporation with a principal place of business at 2155 Stonington Ave, Suite 208, Hoffman Estates, IL 60195 ("Assignee");

NOW THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged,

The undersigned sells, assigns, and transfers to the Assignee, the undersigned's entire right, title, and interest in and to the Applications, including all priority rights arising therefrom, inventions disclosed therein, and patents that the United States or any other country may grant for such inventions, including the right to sue for all past, present, or future infringement of said patents.

The undersigned agrees to execute all papers and perform all other acts necessary to obtain or maintain any patent issuing from the Applications or any counterpart application in the United States or any foreign country, including any continuing, divisional, or reissue application, and any reexamination of any such application, and to execute separate assignments in connection with such applications as Assignee deems necessary or expedient.

The undersigned agrees to execute all necessary papers in connection with any litigation or interference concerning the Applications or any counterpart application, and to cooperate with the Assignee to obtain and present evidence in connection with such litigation or interference.

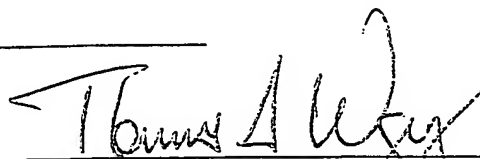
The undersigned authorizes and requests the United States Director of Patents to issue any Letters Patent of the United States resulting from the Applications, any counterpart application, and any reexamination of any of such application, to the Assignee, as assignee of the undersigned's entire interest thereto.

The undersigned covenants that he has full right to convey the interest herein assigned and has not executed, and will not execute, any agreement in conflict herewith.

The undersigned grants Assignee's attorney of record the power to insert on this assignment any further identification necessary or desirable to comply with the rules of the United States Patent and Trademark Office for recording this document, including the serial number of the utility patent application and filing date for same when known.

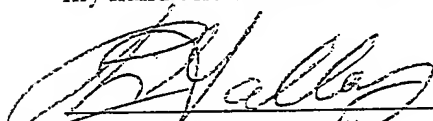
Executed this 31 day of July, 2002,

at ROSEMONT, IL

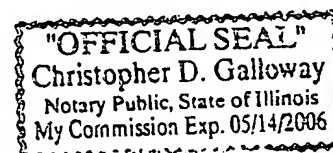

THOMAS A. WOZNY

STATE OF _____ }
COUNTY OF DuPage } SS:

Acknowledged before me, a Notary Public, within and for said County and State. Witness my hand and Notarial Seal this day of July 31, 2002.


Notary Public

My Commission Expires: 5/14/2006



ASSIGNMENT

WHEREAS the undersigned, NICHOLAS NANOS, Roselle, IL, is the maker of an invention that is the subject of a utility patent application filed with the United States Patent and Trademark Office entitled STEERABLE IN-LINE SKATEBOARD, U.S. Application Serial No. 10/039,570, filed October 26, 2001, and PCT Int'l Application No. PCT/US01/46049, filed October 31, 2001; and a utility application entitled STEERABLE IN-LINE STREET SKI, U.S. Application Serial No. 10/068,196, filed February 4, 2002 and PCT Int'l Application No. PCT/US02/14678, filed May 8, 2002 ("the Applications"); and

WHEREAS, TIERNEY RIDES LLC, is a Delaware corporation with a principal place of business at 2155 Stonington Ave, Suite 208, Hoffman Estates, IL 60195 ("Assignee");

NOW THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged,

The undersigned sells, assigns, and transfers to the Assignee, the undersigned's entire right, title, and interest in and to the Applications, including all priority rights arising therefrom, inventions disclosed therein, and patents that the United States or any other country may grant for such inventions, including the right to sue for all past, present, or future infringement of said patents.

The undersigned agrees to execute all papers and perform all other acts necessary to obtain or maintain any patent issuing from the Applications or any counterpart application in the United States or any foreign country, including any continuing, divisional, or reissue application, and any reexamination of any such application, and to execute separate assignments in connection with such applications as Assignee deems necessary or expedient.

The undersigned agrees to execute all necessary papers in connection with any litigation or interference concerning the Applications or any counterpart application, and to cooperate with the Assignee to obtain and present evidence in connection with such litigation or interference.

The undersigned authorizes and requests the United States Director of Patents to issue any Letters Patent of the United States resulting from the Applications, any counterpart application, and any reexamination of any of such application, to the Assignee, as assignee of the undersigned's entire interest thereto.

The undersigned covenants that he has full right to convey the interest herein assigned and has not executed, and will not execute, any agreement in conflict herewith.

The undersigned grants Assignee's attorney of record the power to insert on this assignment any further identification necessary or desirable to comply with the rules of the United States Patent and Trademark Office for recording this document, including the serial number of the utility patent application and filing date for same when known.

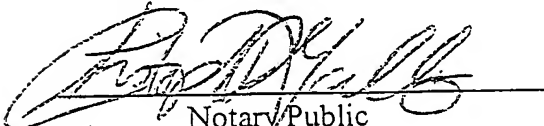
Executed this 8th day of August, 2002,

at ROSELLE, IL.

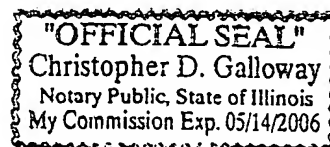

NICHOLAS NANOS

STATE OF }
COUNTY OF DuPage } SS:

Acknowledged before me, a Notary Public, within and for said County and State. Witness my hand and Notarial Seal this day of August, 2002.


Notary Public

My Commission Expires: 5/14/2006



ASSIGNMENT

WHEREAS the undersigned, LUC HEILIGENSTEIN, Chicago, IL, is the maker of an invention that is the subject of a utility patent application filed with the United States Patent and Trademark Office entitled STEERABLE IN-LINE SKATEBOARD, U.S. Application Serial No. 10/039,570, filed October 26, 2001, and PCT Int'l Application No. PCT/US01/46049, filed October 31, 2001; and a utility application entitled STEERABLE IN-LINE STREET SKI, U.S. Application Serial No. 10/068,196, filed February 4, 2002 and PCT Int'l Application No. PCT/US02/14678, filed May 8, 2002 ("the Applications"); and

WHEREAS, TIERNEY RIDES LLC, is a Delaware corporation with a principal place of business at 2155 Stonington Ave, Suite 208, Hoffman Estates, IL 60195 ("Assignee");

NOW THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged,

The undersigned sells, assigns, and transfers to the Assignee, the undersigned's entire right, title, and interest in and to the Applications, including all priority rights arising therefrom, inventions disclosed therein, and patents that the United States or any other country may grant for such inventions, including the right to sue for all past, present, or future infringement of said patents.

The undersigned agrees to execute all papers and perform all other acts necessary to obtain or maintain any patent issuing from the Applications or any counterpart application in the United States or any foreign country, including any continuing, divisional, or reissue application, and any reexamination of any such application, and to execute separate assignments in connection with such applications as Assignee deems necessary or expedient.

The undersigned agrees to execute all necessary papers in connection with any litigation or interference concerning the Applications or any counterpart application, and to cooperate with the Assignee to obtain and present evidence in connection with such litigation or interference.

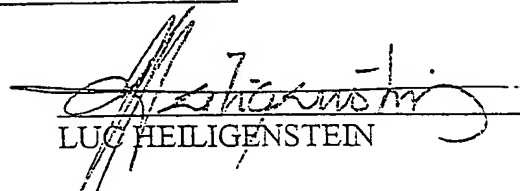
The undersigned authorizes and requests the United States Director of Patents to issue any Letters Patent of the United States resulting from the Applications, any counterpart application, and any reexamination of any of such application, to the Assignee, as assignee of the undersigned's entire interest thereto.

The undersigned covenants that he has full right to convey the interest herein assigned and has not executed, and will not execute, any agreement in conflict herewith.

The undersigned grants Assignee's attorney of record the power to insert on this assignment any further identification necessary or desirable to comply with the rules of the United States Patent and Trademark Office for recording this document, including the serial number of the utility patent application and filing date for same when known.

Executed this 26 day of July, 2002,

at Chicago IL.


LUC HEILIGENSTEIN

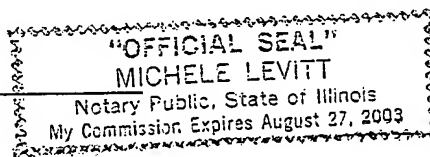
STATE OF IL }
COUNTY OF Cook }

SS:

Acknowledged before me, a Notary Public, within and for said County and State. Witness my hand and Notarial Seal this day of July 26, 2002.


Notary Public

My Commission Expires: 8/27/03



ASSIGNMENT

WHEREAS the undersigned, TYLER TIERNEY, St. Charles, IL, is the maker of an invention that is the subject of a utility patent application filed with the United States Patent and Trademark Office entitled STEERABLE IN-LINE SKATEBOARD, U.S. Application Serial No. 10/039,570, filed October 26, 2001, and PCT Int'l Application No. PCT/US01/46049, filed October 31, 2001; and a utility application entitled STEERABLE IN-LINE STREET SKI, U.S. Application Serial No. 10/068,196, filed February 4, 2002 and PCT Int'l Application No. PCT/US02/14678, filed May 8, 2002 ("the Applications"); and

WHEREAS, TIERNEY RIDES LLC, is a Delaware corporation with a principal place of business at 2155 Stonington Ave, Suite 208, Hoffman Estates, IL 60195 ("Assignee");

NOW THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged,

The undersigned sells, assigns, and transfers to the Assignee, the undersigned's entire right, title, and interest in and to the Applications, including all priority rights arising therefrom, inventions disclosed therein, and patents that the United States or any other country may grant for such inventions, including the right to sue for all past, present, or future infringement of said patents.

The undersigned agrees to execute all papers and perform all other acts necessary to obtain or maintain any patent issuing from the Applications or any counterpart application in the United States or any foreign country, including any continuing, divisional, or reissue application, and any reexamination of any such application, and to execute separate assignments in connection with such applications as Assignee deems necessary or expedient.

The undersigned agrees to execute all necessary papers in connection with any litigation or interference concerning the Applications or any counterpart application, and to cooperate with the Assignee to obtain and present evidence in connection with such litigation or interference.

The undersigned authorizes and requests the United States Director of Patents to issue any Letters Patent of the United States resulting from the Applications, any counterpart application, and any reexamination of any of such application, to the Assignee, as assignee of the undersigned's entire interest thereto.

The undersigned covenants that he has full right to convey the interest herein assigned and has not executed, and will not execute, any agreement in conflict herewith.

The undersigned grants Assignee's attorney of record the power to insert on this assignment any further identification necessary or desirable to comply with the rules of the United States Patent and Trademark Office for recording this document, including the serial number of the utility patent application and filing date for same when known.

Executed this _____ day of _____, 2002,

at _____



TYLER TIERNEY

STATE OF _____ }
 }
COUNTY OF _____ } SS:

Acknowledged before me, a Notary Public, within and for said County and State. Witness my hand and Notarial Seal this day of _____, 2002.

Notary Public

My Commission Expires: _____

ASSIGNMENT

WHEREAS the undersigned, KURT TIERNEY, St. Charles, IL, is the maker of an invention that is the subject of a utility patent application filed with the United States Patent and Trademark Office entitled STEERABLE IN-LINE SKATEBOARD, U.S. Application Serial No. 10/039,570, filed October 26, 2001, and PCT Int'l Application No. PCT/US01/46049, filed October 31, 2001; and a utility application entitled STEERABLE IN-LINE STREET SKI, U.S. Application Serial No. 10/068,196, filed February 4, 2002 and PCT Int'l Application No. PCT/US02/14678, filed May 8, 2002 ("the Applications"); and

WHEREAS, TIERNEY RIDES LLC, is a Delaware corporation with a principal place of business at 2155 Stonington Ave, Suite 208, Hoffman Estates, IL 60195 ("Assignee");

NOW THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged,

The undersigned sells, assigns, and transfers to the Assignee, the undersigned's entire right, title, and interest in and to the Applications, including all priority rights arising therefrom, inventions disclosed therein, and patents that the United States or any other country may grant for such inventions, including the right to sue for all past, present, or future infringement of said patents.

The undersigned agrees to execute all papers and perform all other acts necessary to obtain or maintain any patent issuing from the Applications or any counterpart application in the United States or any foreign country, including any continuing, divisional, or reissue application, and any reexamination of any such application, and to execute separate assignments in connection with such applications as Assignee deems necessary or expedient.

The undersigned agrees to execute all necessary papers in connection with any litigation or interference concerning the Applications or any counterpart application, and to cooperate with the Assignee to obtain and present evidence in connection with such litigation or interference.

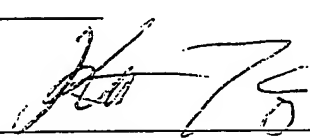
The undersigned authorizes and requests the United States Director of Patents to issue any Letters Patent of the United States resulting from the Applications, any counterpart application, and any reexamination of any of such application, to the Assignee, as assignee of the undersigned's entire interest thereto.

The undersigned covenants that he has full right to convey the interest herein assigned and has not executed, and will not execute, any agreement in conflict herewith.

The undersigned grants Assignee's attorney of record the power to insert on this assignment any further identification necessary or desirable to comply with the rules of the United States Patent and Trademark Office for recording this document, including the serial number of the utility patent application and filing date for same when known.

Executed this _____ day of _____, 2002,

at _____


KURT TIERNEY

STATE OF _____

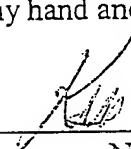
}

SS:

COUNTY OF _____

}

Acknowledged before me, a Notary Public, within and for said County and State. Witness my hand and Notarial Seal this day of _____, 2002.



Notary Public

My Commission Expires: _____

tent ☒

Trademark (

27734-92540; 27734-93149;
27734-93534; 27734-92923

Serial No. (see below) Filed

Applicant(s) Tierney Piles LLC and/or Kurt Tierney et al

Papers filed herewith on SEP 10 2002

☒ Fees \$ 160.00

☒ Assignment

☐ New-Formal Application

☐ Proposed Drawing Correction

☐ Amendment

☐ Priority Document(s)

☐ Notice of Appeal

☐ Req. for Ext. of Time

☐ Appeal Brief

☐ Sheets of Formal Drawing

☐ Other Request for Reexamination in U.S. Application Nos.

10/034,570 & 10/005,196 and International Application Nos.

PCT/US01/46049 and PCT/US02/14678.

Receipt is hereby acknowledged of the papers filed as indicated in connection with above identified case.

COMMISSIONER OF PATENTS AND TRADEMARK:

EXHIBIT B

Chicago

Elkhart

Fort Wayne

Grand Rapids

Indianapolis

South Bend

Washington, D.C.

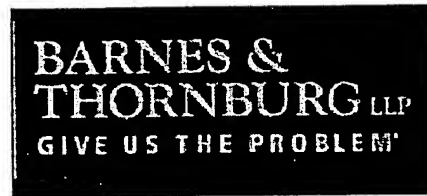
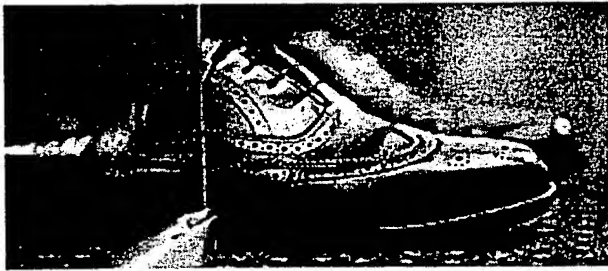


EXHIBIT C

History

Barnes & Thornburg LLP has a rich history of client and community service, innovation, and leadership. The firm was founded in 1940 under the name Barnes, Hickam, Pantzer & Boyd, and soon became known as a leading business law firm. By its 40th anniversary in 1980 the firm had grown to more than 50 attorneys, and in 1981 the firm purchased its headquarters facility in Indianapolis, the former Merchants Bank Building, a classic Chicago-style red-brick and limestone landmark in Indianapolis. From that base the firm has continued its innovative growth through the last two decades.

In 1982 the Barnes firm merged with the Thornburg McGill firm in South Bend, which was the largest law firm in Northern Indiana, a name which had become well known in U.S. legal circles, and one of the most prominent in the Great Lakes region. The firm then became Barnes & Thornburg and bears that well known name to this date. Since then the firm has grown through 20 years of internal expansion and acquisition and merger of smaller but prominent boutique firms. A significant number of prominent attorneys from other major law firms and from federal, state, and local government have also joined B&T's ranks through the years.

Today Barnes & Thornburg LLP is a major law firm with nearly 450 attorneys and professionals practicing in several offices in multiple jurisdictions. From its Midwest roots in Chicago, Elkhart, Fort Wayne, Grand Rapids, Indianapolis and South Bend, and with its Washington, D.C. base in the nation's capital, the firm serves more than 12,000 clients in local, state, regional, national, and international matters.

Barnes & Thornburg LLP has a long history of innovative solutions to legal services, ranging from being a pioneer in multi-office, multi-jurisdictional practice, to utilizing cutting-edge technologies in the 21st century. The firm also has a distinguished history of leadership in business, community, bar association, and pro bono services.

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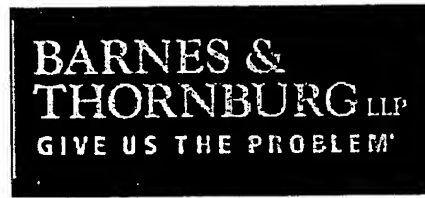


EXHIBIT D

Intellectual Property

- ☐ Antitrust and Trade Regulation
- ☐ Biotechnology
- ☐ BTech Group
- ☐ Business Methods
- ☐ Copyrights
- ☐ Engineering and Scientific Fields
- ☐ Entertainment - Publishing and the Arts
- ☐ Franchises and Product Distribution
- ☐ Information Technology
- ☐ International IP
- ☐ Internet Issues and Disputes
- ☐ IP Clients
- ☐ IP Licensing
- ☐ IP Strategy and Management
- ☐ Licensing-Tech Transfer
- ☐ Litigation
- ☐ Mergers and Acquisitions
- ☐ Nanotechnology
- ☐ Opinions
- ☐ Patent Interferences
- ☐ Patents
- ☐ Registered Patent Attorneys and Agents
- ☐ Rights of Publicity
- ☐ Technology Transactions
- ☐ Trade Dress
- ☐ Trade Secrets
- ☐ Trademark Oppositions and Cancellations
- ☐ Trademarks
- ☐ Unfair Competition and False Advertising

For more information please contact:

Donald E. Knebel

317-231-7214

donald.knebel@BTLaw.com

Barnes & Thornburg LLP's Intellectual Property ("IP") Department helps clients protect, enforce, and fully utilize their intellectual property, and preserve and defend their market advantages, both domestically and internationally. The services offered include:

- Preparing and prosecuting patent applications
- Preparing and prosecuting trademark applications
- Assisting in the transfer of intellectual property,
- Assisting with the IP aspects of mergers, acquisitions, & divestitures
- Litigating patent, trademark, copyright, trade dress, and trade secret cases
- Assisting with franchising and product distribution
- Assisting with antitrust and trade regulation

Our Washington, D.C., office provides assistance in proceedings before

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- The United States Patent and Trademark Office,
- The Copyright Office, and
- The International Trade Commission

With more than 75 attorneys and agents across our seven offices practicing in all aspects of intellectual property law, we have one of the largest intellectual property practice groups in the Midwest and handle national and international matters. We have handled more than

- 15,000 trademarks
- 15,000 patents,

We have represented more than

- 14,000 inventors
- from at least 43 states
- from at least 16 countries in addition to the United States and
- 150 clients in Silicon Valley alone.

Because many of the lawyers in the IP Department have both education and experience in technical disciplines, ranging from electrical and mechanical engineering to chemistry and microbiology in addition to their legal education and experience, we are well positioned and prepared to better understand our clients' needs at both the technical and legal levels.

Our lawyers work with our clients' engineers and scientists at the beginning of research and development projects to help determine how and when to protect and fully utilize the results of those efforts. Our registered patent lawyers prepare, file and prosecute patent applications both in the United States and foreign jurisdictions, often using the procedures for foreign applications established by the Patent Cooperation Treaty ("PCT"). Barnes & Thornburg lawyers counsel clients in identifying and protecting trademarks, trade dress, and copyrightable subject matter that are important to the success and growth of their businesses. When filing patent and trademark applications in foreign countries, Barnes & Thornburg is assisted by a network of foreign legal counsel familiar with local practices and requirements.

Our lawyers also help clients identify, and implement procedures designed to avoid legitimate rights of their competitors in connection with new product clearance investigations. For example, our IP lawyers conduct and supervise patent and trademark searches and render opinions regarding the scope and validity of patents and trademarks owned by others. Our IP lawyers negotiate and draft agreements to obtain intellectual property rights belonging to others. Our lawyers negotiate licenses, assignments, and joint ventures; prepare and register franchise and distribution agreements; and draft non-competition and confidentiality agreements.

Barnes & Thornburg lawyers also help clients understand and comply with U.S. and foreign laws that may govern the marketing of their products, including antitrust laws, laws prohibiting unfair competition, and laws restricting "dumping" of products.

Through their participation in B-Tech, Barnes & Thornburg's Business and Technology Group, our IP lawyers help provide technology-related services to both technology clients (the producers of such technology) and more traditional clients (who are the users of such technology). Our IP lawyers, working through B-Tech, also help technology clients receive "technology-savvy" help with more traditional issues, such as real estate, employment, and financing.

When competitors refuse to recognize the rights of our clients, our IP lawyers counsel clients on ways to enforce their rights, including the use of litigation. Our IP Department has extensive experience litigating cases in jurisdictions and forums throughout the United States and in many foreign countries, ranging from opposition proceedings in the United States Patent and Trademark Office, to antitrust class actions, to proceedings before the International Trade Commission. The litigation handled by our lawyers involves patents, trademarks, trade dress, and copyrights; antitrust and unfair competition; violation of non-compete agreements; franchise, dealer and distributor termination; and trade secrets. See our IP Litigation Page for more information.

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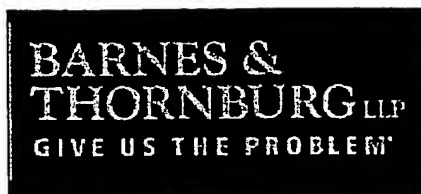


EXHIBIT E





Thomas J. Donovan
Chicago

One North Wacker Drive
Suite 4400
Chicago, Illinois 60606-2833

Phone: 312-214-8329

Fax: 312-759-5646

E-mail: thomas.donovan@BTLaw.com

-  [News Releases](#)
-  [Printable PDF Bio](#)
-  [E-mail This Page](#)

Thomas J. Donovan is a partner in the Chicago office of Barnes & Thornburg LLP and a member of the Intellectual Property Department.

He focuses his practice on patent and trademark litigation and prosecution, unfair competition, and trade secrets. Mr. Donovan has counseled clients on intellectual property issues, including litigation; the preparation and prosecution of U.S. and foreign patent and trademark applications; rendering patent validity and infringement opinions; trademark issues; and the negotiation and drafting of patent, trademark, and copyright licenses.

He regularly represents clients in a wide variety of industries, including Internet and high-tech businesses, consulting and engineering firms, manufacturing, distribution, industrial equipment, consumer goods, and merchandising businesses.

Mr. Donovan regularly litigates patent, trademark, and copyright disputes in the federal courts, and litigates patent and trademark disputes in the U.S. Patent and Trademark Office. He also has been involved in pre-litigation counseling and avoidance.

Mr. Donovan received his B.S. in mechanical engineering in 1982 from the University of Illinois. He received his J.D. from the Chicago-Kent College of Law in 1987 and is now a faculty member at that institution. He is admitted to practice in the state of Illinois and before the U.S. Patent and Trademark Office. Mr. Donovan is also admitted before the U.S. District Courts for the Northern and Central Districts of Illinois and the U.S. Court of Appeals for the Federal Circuit. He is a member of the Intellectual Property Law Association of Chicago.

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Kurt Tierney – Tierney Rides
Our Case No. 05194

EXHIBIT F

LIST OF FILINGS AND APPLICATIONS

PCT Application No. 0501-46049 for STEERABLE IN-LINE SKATEBOARD
filed on 10/31/01
B&T Case No. 92923

PCT Application No. 0502/14678 for STEERABLE IN LINE STREET SKIS
Filed on 5/8/02
B&T Case No. 93534

U.S. Provisional Application for STEERABLE IN-LINE SKATEBOARD
No. 60/243,726 filed on 10/27/00
B&T Case No. 91215

U.S. Provisional Application for STEERABLE IN-LINE STRESS SKI
SN 60,266,725, filed on 2/5/01
B&T Case No. 91863

U.S. Patent Application for STEERABLE IN-LINE STREET SKIS
SN 10/068,196, filed on 2/4/02
B&T Case No. 93149

Japanese Trademark Registration No. 4613224 for TIERNEY RIDES
IC 28, Registered 10/18/02, SN 200/085867
B&T Case No. 92719

U.S. Trademark Registration for TIERNEY RIDES, IC 9, (Supplemental Register)
Registration No. 2,647,537, registered on November 5, 2002
SN 76/319434,
B&T Case No. 92735

U.S. Trademark Registration for TIERNEY RIDES, (Supplemental Register) IC 28 & 37
Registration No. 2,560,657, registered on April 9, 2002
SN 76/140824
B&T Case No. 92444

U.S. Trademark Registration for TIERNEY RIDES (Supplemental Register) IC 28
Registration No. 2,641,333, registered on October 22, 2002
SN 76/318,983
B&T Case No. 92728

US Trademark Registration for TR (and design), IC 9
Serial No. 76/321,488, filed on October 4, 2001 (abandoned)
B&T Case No. 92734

U.S. Trademark Application for R (and design) IC 16
Serial No. 76/321,394, filed on 10/4/01 (abandoned)
B&T Case No. 92737

U.S. Trademark Application fro TIERNEY RIDES IC 16
Serial No. 76/319127, filed 9/28/01 (abandoned)
B&T Case No. 92729

U.S. Trademark Application for TR (and design) IC 28
Serial No. 76/321,636, filed on 10/04/01 (abandoned)
B&T Case No. 92727

U.S. Trademark Application for RIDE ME. RIDE ME NOW, IC 25
Serial No. 76/319433 filed on 9/28/01 (abandoned)
B&T Case No. 92730

U.S. Trademark Application for TIERNEY RIDES LOGO IC 25
Serial No. 76/321,178 filed on 10/4/01 (abandoned)
B&T Case No. 92731

U.S Trademark Application for TIERNEY RIDES IC 25
Serial No. 76328,988 filed on 9/28/01 (abandoned)
B&T Case No. 92732

U.S. Trademark Application for TIERNEY IC 28
Serial No. 76/140,218 filed on 10/4/00 (abandoned)
B&T Case No. 92443

U.S. Trademark Application for TORSION RESPONSE TECHNOLOGY IC 28
Serial No. 76/318980 filed on 9/28/01 (abandoned)
B&T Case No. 92726

U.S. Trademark Application for TORSION RESPONSE SYSTEM IC 28
Serial No. 76/238430 filed on 4/10/01 (abandoned)
B&T Case No. 92271

U.S. Trademark Application for TORSION RESPONSE TECHNOLOGY IC 28
Serial No. 76/247,965 filed on 4/27/01 (abandoned)
B&T Case No. 92366

U.S. Trademark Application for T-RIDE IC 28

Serial Number 76/197,354 filed on 1/22/01 (abandoned)
B&T Case No. 92445

U.S. Trademark Application for T-BOARD IC 28
Serial Number filed on 3/27/01
B&T Case No: 92446

U.S. Servicemark Application for IT'S ALL ABOUT THE RIDE IC IC 41
Serial No. None
B&T Case No. 92447

U.S. Trademark Application for RIDE ME. RIDE ME, NOW IC 9
Serial No. 76/318984 filed on 9/28/01 (abandoned)
B&T Case No. 92733

U.S. Trademark Application for RIDE ME. RIDE ME, NOW IC 16
Serial Number 76/318,982 filed on 9/28/01 (abandoned)
B&T Case No. 92736

Japanese Trademark Application for T-BOARD IC 28
Serial No. 2001/085866 filed on 9/21/01
B&T Case No. 92741

Mexican Trademark Application for TIERNEY RIDES IC 28
Serial No. 509219 filed on 9/27/01, Registered on 1/29/02
Renewal Due on 9/27/2011
B&T Case No. 92739

Mexican Trademark Application for T-BOARD IC 28
Serial No. 509218 filed on 9/27/01, Registered on 1/29/02
Renewal due on 9/27/11
B&T Case No. 92740

European Trademark Application for TIERNEY RIDES IC 28
Serial No. 2381556 filed on 9/18/01, Registered on 11/5/02
Renewal on 9/18/11
B&T Case No. 92720

European Trademark Application for T-BOARD IC 28
Serial No. 2381077, filed on 9/18/01
B&T Case No. 92721

Canadian Trademark Application for TIERNEY RIDES IC 28
Serial No. 1,116,559, filed on 9/25/01
B&T Case No. 92722

Canadian Trademark Application for T-BOARD
Serial No. 1,116,560, filed 9/25/01
B&T Case No. 92724



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BARNES & THORNBURG, LLP
P.O. BOX 2786
CHICAGO, IL 60690-2786

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FEB 03 2006

OFFICE OF PETITIONS

In re Application of
Tierney, et al.
Application No. 10/039,570
Filed: October 26, 2001
Attorney Docket No. 27734/92540

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), or in the alternative 37 CFR 1.137(b), filed November 23, 2005, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is dismissed.

This application became abandoned for failure to timely reply to the non-final Office action mailed February 24, 2003. Accordingly, this application became abandoned on May 25, 2003. A Notice of Abandonment was mailed on November 26, 2003.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

This petition lacks item (3) above.

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner asserts financial difficulty as a cause of delay. Petitioner has not explained how financial difficulty caused the unavoidable delay. Additionally, a showing of “unavoidable” delay based upon financial difficulty must be supported by a complete showing of the responsible person’s or entity’s financial condition during the relevant period, including income, expenses, assets, credit and obligations, which made the delay unavoidable. Such documentary evidence of financial difficulty has not been submitted.

Furthermore, petitioner states various crimes and fraudulent activities have been committed against the applicant. However, no police reports or other documentary evidence has been submitted in support.

Additionally, the record indicates that the law firm of Barnes & Thornburg, LLP was responsible for prosecution of the above-identified application when the reply necessary to avoid abandonment was due. Therefore, petitioner must provide a statement from the law firm of Barnes & Thornburg, LLP explaining why action was not timely taken to prevent the above-identified application from becoming abandoned. Such a statement has not been submitted.

Lastly, please note, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 U.S.P.Q.2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 U.S.P.Q.2d 1130, 1132 (D.N. Ind. 1987). Further, please note, the Patent and Trademark Office is not the proper forum for resolving disputes

between applicants and their representatives. See Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995).

Accordingly, the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).

However, the petitioner has requested that, in the alternative, that the petition be considered under 37 CFR 1.137(b).

The petition under 37 CFR 1.137(b) is **granted**.

The statement of unintentional delay presented in the petition does not comply with the current rule. Effective December 1, 1997, 37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" be submitted. However, the statement presented will be accepted and construed as meaning that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. At 53160 and 53178, 1203 Off. Gaz Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must so notify the Office.

The additional \$500.00 for a petition under 37 CFR 1.137(b) has been charged to deposit account no. 50-2063, as per the authorized found in the instant petition.

Please note, the "Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address" has NOT been entered. As the document was signed by the assignee, a statement under 37 CFR 3.73(b) **MUST** be submitted.

A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

The file is being forwarded to Technology Center 3600 for review of the amendment filed November 23, 2005, *in due course*.

Telephone inquiries should be directed to the undersigned at (571) 272-3228.



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cc.
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